

REMARKS

Please cancel claim 9. The subject matter of claim 9 is already incorporated within claim 1, as component "C".

Rejection of Claims 1-6, 9, 10 and 13 under 35 U.S.C. § 103

Claims 1-6, 9, 10 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Maag, DE-A-197,57,082 (WO 99/26733), in view of Richard, U.S. 5,091,211. As the Examiner has referred in the Office Action to the U.S. counterpart to DE-A-197,57,082, Applicant also refers herein to U.S. 6,531,199 as "Maag".

The Examiner has correctly stated that Maag fails to teach a filler coating composition comprising at least one compound having at least one phosphoric acid group and at least one free-radically polymerizable double bond. However, Applicant respectfully submits that the Examiner has incorrectly characterized Richard as disclosing that the addition of a compound having a phosphoric acid group and a double bond such as methacryloyl-modified phosphoric acid derivative to a radiation curable coating composition comprising acrylourethane and reactive free-radical polymerizable monomers "provides strong adhesive bond of the coating to a metal substrate". Firstly, Richard is in fact directed to an improvement in coating of synthetic plastic substrates. The Examiner's attention is respectfully directed to the entire paragraph beginning at column 1, line 55 of Richard. The cited text states that while the "coating compositions of the invention are known to provide strong adhesive bonds to metal substrates, the same coatings have failed to provide bonds of satisfactory strength on synthetic plastic substrates." (Emphasis added). Applicant respectfully submits that the Examiner has misinterpreted this statement as applying to the claimed invention of Richard, when in fact the statement applies to previously known compositions- i.e., compositions not containing at least one phosphoric acid group and containing at least one free-radically polymerizable double bond, as recited in the present claims, let alone compositions containing the other features of the present claims. For support of Applicant's interpretation of the cited lines from Richard, Applicant respectfully directs the Examiner to the abstract, which recites the invention as being an "improvement" to a method of coating a vinyl resin layer with a coating composition

comprising a radiation curable acrylourethane, a photoinitiator and at least one unsaturated addition-polymerizable monomer, the "improvement comprising including in said coating composition a monester or diester of phosphoric acid". There is no disclosure, teaching, or suggestion in Richard of the use of a coating composition containing a compound having at least one phosphoric acid group on a metal substrate. In fact, Richard effectively teaches, at lines 55-60, that the disclosed phosphoric acid ester-containing compositions are intended only for use on synthetic plastic substrates, whereas known coating compositions are apparently deemed by Richard to be adequate for metal substrates. Moreover, Richard fails to address in any way what constitutes "strong adhesive bonds" to metal surfaces, where an improvement might be desired, e.g., under conditions of weathering, thermal exposure, or humidity, or what might constitute an improvement in bonding of coatings to metal substrates. Thus, Richard is in fact inapplicable to the present claims. There is certainly no motivation for one skilled in the art to combine Richard with Maag, which does disclose coating metal surfaces. In particular, the presently claimed compositions provide primer surfacer coatings that can be overcoated without showing edge marks, and which fulfill standard requirements of automotive repair coating. There would be no reason for a skilled person to consider the disclosures of Richard in connection with automotive coating, let alone to combine the disclosures of Richard with those of Maag. Applicant respectfully submits that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

Finally, Richard discloses only the addition of a phosphoric acid ester to coating compositions to provide satisfactory adhesion on synthetic plastic substrates. Nothing is disclosed or even suggested in Richard regarding the addition of a phosphoric acid group-containing compound to UV curable compositions comprising components A and B of the present claims, or the improvement provided in coating to metal substrates thereby.

The stated objective of Maag is to provide environmentally acceptable surfacer coating compositions that can be applied at high layer thicknesses and high pigment concentrations. The coating compositions can be applied without solvents. Maag fails to disclose, teach or suggest the present claims, alone or in combination

with Richard. Maag lacks any disclosure or suggestion of a coating composition comprising a compound having at least one phosphoric acid group and containing at least one free-radically polymerizable double bond. As already stated hereinabove, there is no motivation in Maag or Richard to combine the two references, since Richard is directed to coating plastics and Maag is directed to coating for automotive repair. Accordingly, Maag does not disclose, teach, or suggest the present claims and cannot be properly combined with Richard except by use of impermissible hindsight. Applicant therefore submits that claims 1-6, 10 and 13 are not obvious over Maag and/or Richard. The rejection of claim 9 has been obviated by its cancellation.

Rejection of Claim 8 under 35 U.S.C. § 103

Claim 8 was rejected under 35 U.S.C. § 103(a) as unpatentable over Maag in view of Richard, further in view of Brehm. As an initial matter, Applicant notes that U.S. patent no. 5,596,043 is given in the Office Action as being the patent number for Brehm. However, Applicant has a copy of U.S. Patent No. 5, 596,043, and the named inventors thereof are Harris and Foukes. Although Harris is directed to coatings, Applicant is unable to locate any of the text cited in the Office Action, in Harris. Applicant has located U.S. Patent No. 5,700,576, which lists Brehm as an inventor and is entitled "UV Curable Scratch-Resistant Varnish Having a Thickener Which Becomes Bound in the Composition of the Varnish by Polymerization" ("Brehm '576") Applicant notes the disclosure in Brehm 576 at column 5, line 59, of isobornyl methacrylate as a reactive thinner. Accordingly, Applicant relies herein on Brehm '576 but requests that the Examiner confirm or correct such reliance by Applicant.

Maag and Richard, alone and in combination, lack any disclosure of isobornyl methacrylate. Brehm '576, like Richard, is directed to coating plastics. Accordingly, there is no motivation for a skilled person to combine Brehm with Maag.

The Examiner has apparently cited Brehm for the disclosure therein of isobornyl methacrylate. The Examiner has correctly stated that Maag and Richard fail to disclose isobornyl methacrylate. The Examiner has pointed to disclosure in Brehm of "automobile parts". However, the "automobile parts" referred to in Brehm are made of thermoplastic materials, and, accordingly, there is no reason for a

person of ordinary skill in the art to conclude that the coatings of Brehm, even including isobornyl methacrylate, are suitable for use in coating metal substrates. Brehm, in combination with Richard, does not disclose or suggest any coatings of metal substrates and there is no suggestion in either Brehm or Richard that the compositions disclosed therein are suitable for coating metal substrates, as recited in the present claims. Accordingly, Applicant submits that the combination of Maag with Richard and/or Brehm fails to disclose, teach, or suggest claim 8 of the present application and that Claim 8 is not obvious over Maag, Richard and/or Brehm, alone or in combination.

CONCLUSION

Applicant respectfully submits that the present claims are patentable over Richard, Brehm, and Maag, alone or in combination. Accordingly, prompt favorable action and issuance of a Notice of Allowance for all of pending claims 1-6, 8, 10 and 13 are respectfully requested.

The Commissioner is authorized to charge any remaining fee due, or credit any overpayment, to Deposit Account No. 04-1928 (E.I. du Pont de Nemours and Company).

Respectfully submitted,

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